

### **REMARKS**

In this Amendment, Applicant has amended Claims 21, 23, 32 – 35, 40, 46 and 52. Claims 21, 23, 32 – 35, 40, 46 and 52 have been amended to overcome the rejections and further specify the embodiments of the present invention. In addition, the Fig. 2 has been amended to show every feature of the claims and the specification has been amended to provide reference to the drawings. The support for the amendments to the claims, specification and drawing can be found throughout the specification. It is respectfully submitted that no new matter has been introduced by the amended claims, specification and drawing. All claims are now present for examination and favorable reconsideration is respectfully requested in view of the preceding amendments and the following comments.

### **OBJECTION TO DRAWINGS:**

The drawing have been objected as failing to show every feature of the invention specified in the claims under 37 CFR 1.83(a).

It is respectfully submitted that the Fig. 2 has been amended to show the restricted travel of the control member in the X-Y plane. In Fig. 2, a horizontal double-headed arrow F aligned with the major axis of the control member 1 and extending forwardly (i.e. in the top left direction in the drawing) and backwardly (i.e. in the bottom right direction) from the axis of rotation A is shown. The forward extent of the double-headed arrow is equal to the width of the gap between the forward end of the control member 1 and the cylindrical wall of the well 7 and the backward extent of the double-headed arrow is equal to the corresponding gap width between the opposite end of the control member 1 and the wall. Because the direction, the position and the length of the double-headed arrow F can be derived from the original version of Fig. 2, no new matter has been added by the amendment.

In addition, the specification has been amended to add a paragraph on page 9, line 6 to recite the amended feature of Fig. 2. Because the direction, the position and the length of the double-headed arrow F can be derived from the original version of Fig. 2 and Claims 32 – 35, no new matter has been added by the amendment.

Therefore, the objection to the drawing has been overcome and withdrawal of objection is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112 FIRST PARAGRAPH:

Claims 32 – 35 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to satisfy the written description requirement and containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is respectfully submitted that in view of the presently submitted amendments, the rejection has been overcome. The description on page 8, lines 13 – 16 of specification clearly states that “[T]he translation of the post 10 in the x and y directions is resiliently constrained by these sensors (or other coupling) such that translation of the platform 1 is so small as to be imperceptible to the user.” Furthermore, this paragraph indicates that the sensors 13 and 14 can be thick film strain gauges which could certainly be selected to fulfill the requirement in Claim 35. The feature of “means for restricting the travel” of the control member is provided by the cylindrical wall of the well 7, in conjunction with the feature of the penultimate sentence of the third paragraph on page 8 of the original specification as filed that the support 15 “can be made resilient.” The required degree of travel can be provided as a matter of routine by selection of the thickness of the gap between the control member and the wall of the well 7 and by adjustment of the resilience of the support 15.

Therefore, the rejection under 35 U.S.C. § 112, first paragraph has been overcome. Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, first paragraph, is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112 SECOND PARAPGRAPH:

Claims 32 – 35 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is respectfully submitted that the rejections have been overcome by this amendment. Claims 32 – 34 have been amended to delete the reference to “said plane.” Claim 35 has been amended to replace “the x-y plane” with “said x and y directions” to be consistent with Claim 21.

Therefore, the rejection under 35 U.S.C. § 112, second paragraph, has been overcome. Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102:

Claims 21 – 23, 25, 35 – 38, 41 – 42, 46 and 50 – 54 have been rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Hoggarth (US 6,654,044), hereinafter Hoggarth.

Applicant traverses the rejection and respectfully submits that the present-claimed invention is not anticipated by the cited reference. More specifically, Claims 21 and 46 have been amended to specify that “said control device having a profile which is sufficiently low to enable it to be accommodated in the thickness of a base portion of a clamshell design laptop computer.” Claims 22 – 23, 25, 35 – 38 and 41 – 42 also include these features by their dependence on Claim 21 and 46. It is respectfully submitted that

there is sufficient support for the amendment in the specification, for example, the description on page 3, lines 2 – 4. In addition, for Claim 25, Hoggarth fails to disclose the claim limitation that the outer surface of the control member and the inner surface of the well are “spaced apart therefrom to define a gap”, as there is no gap between the joystick bottom surrounding surfaces 72, 74 and the post inner surfaces 52, 54. Otherwise, there will be no electrical contacts and the joystick will not be operable (see col. 4, lines 42 – 44). For Claims 46 and 51, it is respectfully submitted that the movement of a joystick according to Hoggarth for gaming purpose should not be “imperceptible” to a user. For Claims 52 – 54, using a joystick according to Hoggarth should be different from using a conventional computer mouse. Furthermore, regarding Claim 50 – 54, Applicant respectfully submitted that the joystick as disclosed in Hoggarth is not a “low-profile” control device as specified in Claim 50 – 54. It is clear that Hoggarth does not teach or suggest the features as amended. Therefore, Hoggarth does not anticipate Claims 21 – 23, 25, 35 – 38, 41 – 42, 46 and 50 – 54.

In summary, the newly presented claims are not anticipated by Hoggarth and the rejection under 35 U.S.C. § 102 (b) has been overcome. Accordingly, withdrawal of the rejection under 35 U.S.C. § 102 (b) is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103:

Claims 29 – 35, 45 and 48 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Hoggarth. Claims 26, 39 – 40, 43, 44 and 49 have been rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Hoggarth in view of Klein (US 6,205,01) hereinafter Klein.

Applicant traverses the rejection and respectfully submits that the embodiments of present-claimed invention are not obvious over Hoggarth or over Hoggarth in view of Klein. In particular, Claim 40 has been amended to specify that “said pointing device having a profile which is sufficiently low to be accommodated in the thickness of said base portion.” As stated above, the embodiments of the present invention as presently

defined in Claims 26, 29 – 35, 39 – 40, 43 – 45 and 48 – 49 are different from the disclosure in Hoggarth. Hoggarth fails to teach or disclose a control device having a profile which is sufficiently low to enable it to be accommodated in the thickness of a base portion of a clamshell design laptop computer or a pointing device having a profile which is sufficiently low to be accommodated in the thickness of said base portion.

It is respectfully submitted that the teaching of Hoggarth provides a control device, namely a joystick, which cannot be accommodated in the base portion, but is removable instead. This involves numerous disadvantages, such as possible damages to the underlying track point mounting if the screen portion of the computer were inadvertently knocked against the joystick, the risk of loosing the joystick, poor electrical contact between the joystick and the track point contacts, etc. The present invention as claimed avoids these problems by the transformation of the track point device into a fundamentally different device which can be operated by two or more spaced apart fingertips of a user. As stated in paragraph number 3 of the published specification of the present invention, accurate control of the cursor is difficult with such “pointing stick/nib” devices and as stated in paragraph number 20 of the published specification, two or more fingertips can accurately apply a desired force in a desired direction “in a way similar to the way fingers are used to push a desktop mouse.” The modification of the track point nib proposed in Hoggarth points (both literally and figuratively) in a different direction from the modification proposed by the present invention. Hoggarth suggests upward extension to obtain the advantage of a joystick whereas the present invention teaches lateral extension in order to achieve the advantages of a mouse but without the attendant disadvantages such as the need for an appreciable area in which to move the mouse and also a connecting cable.

Although Klein discloses a pointing device located in the wrist-rest surface of a laptop computer, Hoggarth teaches that the joystick is advantageously mounted at a point of maximum stability, which is the central location of the keyboard (see column 3, lines 26 – 32 of Hoggarth). Therefore, there is no motivation to modify the construction of Hoggarth by moving the joystick to the wrist-rest area as disclosed in Klein. Such

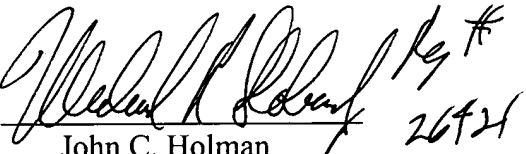
combination will render the device inoperable. In summary, there is no motivation to modify Hoggarth or combine Hoggarth with Klein. Even if they are combined, Hoggarth and Klein will not render the present claimed invention obvious. One of ordinary skill in the art would not discern the present invention as claimed at the time of its invention.

Therefore, the newly presented claims are not obvious over Burrell in view of Waldman and the rejection under 35 U.S.C. § 103 has been overcome. Accordingly, withdrawal of the rejections under 35 U.S.C. § 103 is respectfully requested.

Having overcome all outstanding grounds of rejection, the application is now in condition for allowance, and prompt action toward that end is respectfully solicited.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By  #  
John C. Holman 26421  
Registration No. 22,769 for

Date: February 24, 2005  
(202) 638-6666  
400 Seventh Street, N.W.  
Washington, D.C. 20004  
Atty. Dkt. No.: P67148US1

**Amendments to the Drawings:**

The attached sheet of drawing includes changes to Fig. 2. This sheet, which includes Figs. 1 – 2, replaces the original sheet including Figs. 1 – 2. It is respectfully submitted that there is sufficient support for the amended Fig. 2 in the specification, especially the original Fig. 2, descriptions at page 9, lines 6 of the amended specification and original Claims 32 – 35.

Attachment: Replacement Sheet  
Annotated Sheet Showing Changes



Appl. No. 10/816,941  
Amdt. Dated Feb. 24, 2005  
Reply to Office Action of Sep. 24, 2004  
Replacement Sheet  
Annotated Sheet Showing Changes

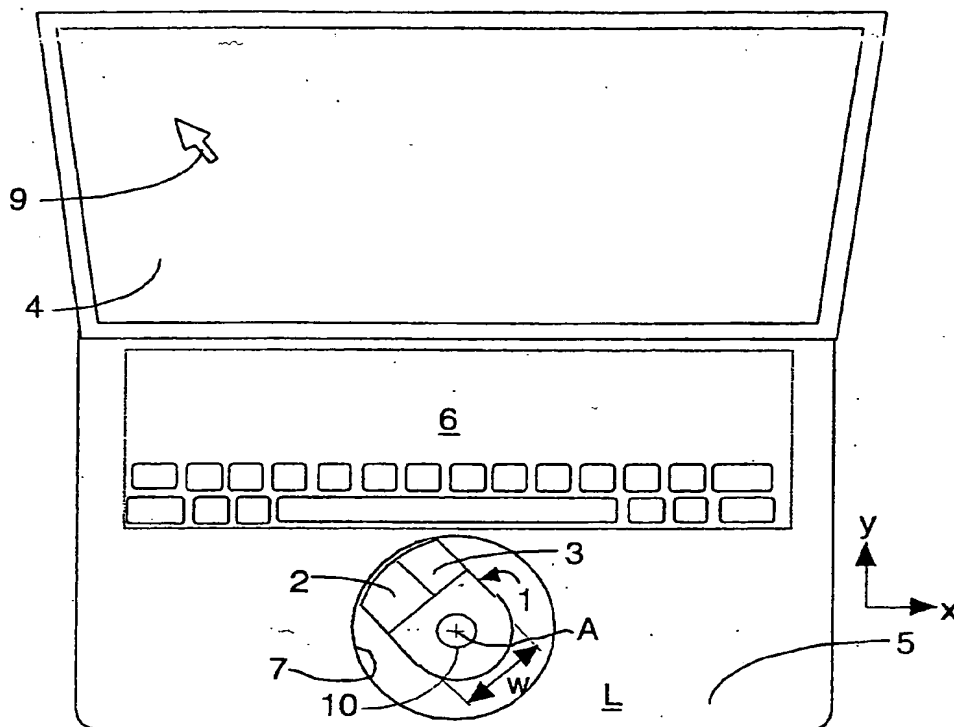


Figure 1

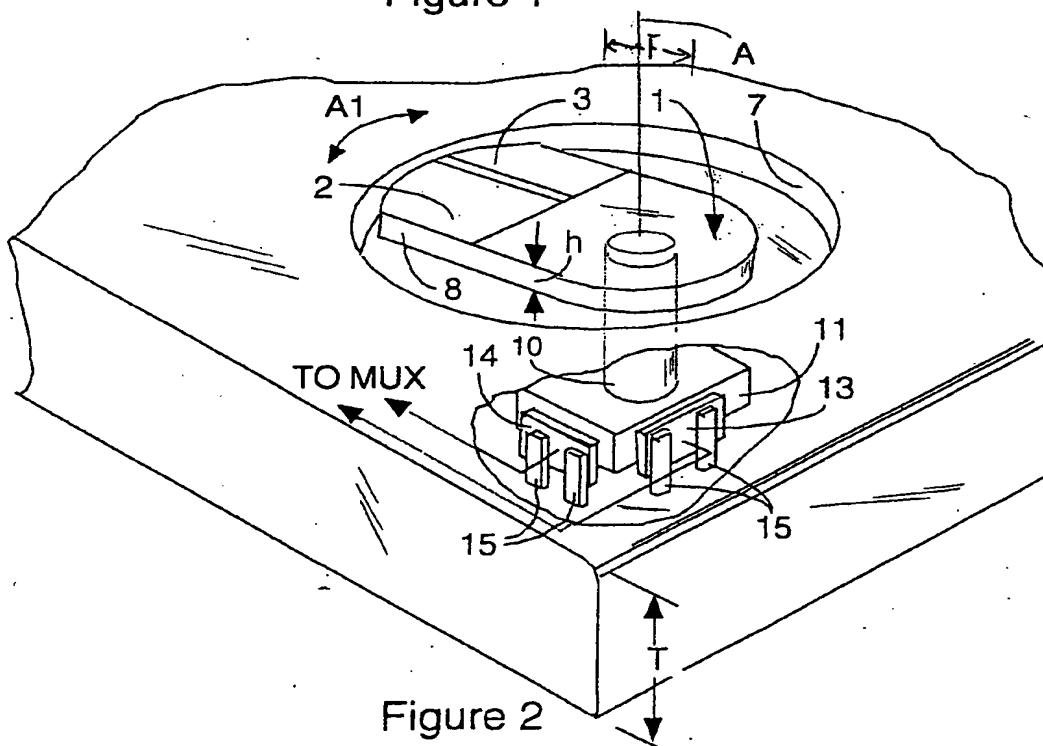


Figure 2